

REMARKS

The claims were either rejected on the ground of nonstatutory obviousness-type double patenting or provisionally rejected on the ground of nonstatutory obviousness-type double patenting. The provisional rejections are believed not to require further comment at the present time as they are provisional. Reconsideration and withdrawal of the remaining rejections is respectfully requested.

U.S. Patent No. 6,945,980

Claims 1 and 3-35 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-14 and 1-12 of U.S. Patent No. 6,945,980. It was advanced:

Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same subject matter a surgical fastener, a first needle, a second needle, flexible members coupled to needles and the ends of the surgical fastener/clip and all the limitations of the application are the obvious variants of when combines claims 13-14 of the patent to other claims of the patent.

First, the language provided above and set forth in the Office Action does not correspond to the particular language of the claims. Nor does it describe the invention as claimed. Applicant further submits that the assertion “and all the limitations of the application are the obvious variants of when combines claims 13-14 of the patent to other claims of the patent” does not make sense and does not conform with the Patent Office standards for rejecting a claim on the ground of obviousness-type double patenting.

According to MPEP §804.03 IIIB(1), any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims-a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim of the patent.

And when considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *Id.*

Each of the independent claims, claims 1, 13, and 14, of U.S. Patent No. 6,945,980 recite among other things which are not recited in the application claims, “a closed configuration having a shape of two or more stitches.” However, this difference was not mentioned in the Office Action. Nor has any reason been advanced to support a conclusion that claim 1 of the present application or any claim in the present application would have been an obvious variation of the invention defined in a particular claim in U.S. Patent No. 6,945,980 such as any one of claims 1, 13, or 14.

There are numerous other differences between the claims in the application and the claims in the patent that went unmentioned. For example, it was not explained how claim 26, which recites a “knotted portion” and a “bore having a portion with a diameter less than that of a section of the knotted portion,” would have been an obvious variation of any claim in U.S. Patent No. 6,945,980.

Since a case of nonstatutory obviousness-type double patenting has not been made, Applicant requests withdrawal of the rejection.

U.S. Patent No. 6,926,730

Claims 1 and 3-35 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,926,730. It was advanced:

Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same subject matter a surgical fastener, a first needle, a second needle, flexible members coupled to needles and the ends of the surgical fastener/clip and all the limitations of the application are the obvious variants of when combines claim 1 of the patent to other claims of the patent.

Withdrawal of this rejection is respectfully requested for reasons similar to those provided above. First, the language provided above and set forth in the Office Action does not correspond to the particular language of the claims. Nor does it describe the invention as claimed. Applicant further submits that the assertion “and all the limitations of the application are the obvious variants of when combines claim 1 of the patent to other claims of the patent” does not make sense and does

not conform with the Patent Office standards for rejecting a claim on the ground of obviousness-type double patenting.

Claims 1 of U.S. Patent No. 6,926,730 recites, among other things which are note recited in the application claims, “a needle holder including an outer tube and an inner member which has a front end adapted to grab said needle and is slidable inside said outer tube. However, this difference was not noted in the Office Action. Nor has any reason been advanced to support a conclusion that claim 1 of the present application or any claim in the present application would have been an obvious variation of the invention defined in a particular claim in U.S. Patent No. 6,926,730.

Since a case of nonstatutory obviousness-type double patenting has not been made, Applicant requests withdrawal of the rejection.

If the Examiner decides to maintain any of the rejections discussed above, the undersigned requests that the Examiner clearly state the differences between the inventions defined by the conflicting claims (a claim in the patent compared to each rejected claim in the application) and the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim of the patent.

Provisional rejections:

The remaining rejections in the Office Action are “provisional” rejections and are believed to be improper. However, it is believed that since they are provisional rejections they do not require further comment at the present time.

CONCLUSION

Applicant submits that the pending claims are in condition for allowance and respectfully requests the issuance of a formal Notice of Allowance at an early date. If a telephone interview would advance prosecution of the application, the Examiner is invited to telephone the undersigned at the number provided below.

In the unlikely event that the transmittal letter is separated from this document and/or the Patent Office determines that an extension and/or other relief is required, Applicant petitions for

any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due, including additional claims fees, in connection with the filing of this document to Deposit Account No. 13-2546 referencing Attorney Docket No. P-21544.02.

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